

Administrative Panel Decision

In the matter of

Between

Paypal, Inc

And

Webpod.com

Case No: KLRCA/DNDR/2011/24

1. The Parties

- 1.1 The Claimant is PayPal, Inc of United States of America with an address at 2211 N 1st St, San Jose, California 95131-2021, United States of America.
- 1.2 The Respondent is Webpod.com with an address at PPKT Tech Biz Lab, Kompleks Eureka, 11800 USM, Pulau Pinang, Malaysia.

2. The Domain Name and Registrar

- 2.1 The Domain Names in issue are <paypal.com.my> and <paypal.my> and the Registrar is MYNIC Bhd.

3. Procedural History

- 3.1 The Complainant filed its Complaint on 27th December 2010 with the Regional Centre for Arbitration, Kuala Lumpur (“the Centre”). On 21st January 2011, the Centre transmitted a request to MYNIC for verification of the identity of the domain name holder. MYNIC transmitted its response confirming that the Respondent is listed as the registrant of the domain names, and provided its contact details.
- 3.2 The Centre verified that the Complaint is complete and satisfied the formal requirements of the MYNIC Domain Name Dispute Resolution Policy and Rules, and the Centre’s Supplemental Rules.
- 3.3 In accordance with the Rules, the Centre formally notified the Respondent of the Complaint, and the proceedings commenced on 24th January 2011.
- 3.4 The Centre appointed a three-member panel consisting of Dr. Clive Trotman, Assoc. Prof. Susanna H.S. Leong and presided by Prof. Dr. Ida Madieha bt. Abdul Ghani Azmi.

4. Factual Background

- 4.1 The Complainant PayPal, Inc, a US company, is the owner of the trade mark PAYPAL in many national and international jurisdictions and numerous classes. The Complainant provides the service of online payment system and is available in 190 markets and 24 currencies around the world.
- 4.2 The Complainant has secured its ownership of the PAYPAL through extensive national and international trade mark registrations. In US, the trade mark was registered on 5 Nov 2002 and the Community Trade Mark was registered on 4 December 2000. The two Malaysian trade mark registrations were secured for several classes of goods and services and were registered on 7 October 2005 and 24 April 2007.
- 4.3 The Complainant owns numerous domain names consisting of the term PAYPAL, including, for instance, the domain names <paypal.com>, <paypal.co.uk>, <paypal.es>, <paypal.it>, <paypal.sg>, <paypal.com.sg>, etc.
- 4.4 The disputed domain name <paypal.com.my> was registered on 11 August 2004 and the domain name <paypal.my> was registered on 15 January 2008. The WHOIS database search results show that Webpod.com is the registrant of the disputed domain names.
- 4.5 The Complainant had sent a cease and desist letter dated on 30 August 2010. The letter was never responded to.
- 4.6 A few days after the cease and desist letter, the registered domain names stopped resolving to the URL www.paypal.com and started pointing to the URL www.ebayar.com instead. Recently, on or around 1 December 2010, both the domain names were redirected to the Complainant's website at <https://paypal.com/my/mrb/pal+CTUXNELQLS6L>, to which both Domain Names currently point.

5. Parties Contentions

A. Complainant

- 5.1 The Complainant contends that the Respondent has registered and/or used the disputed domain names in bad faith on several grounds.
- 5.2 The disputed domain names <paypal.com.my> and <paypal.my> is identical to the Complainant's trade mark PAYPAL with the mere addition, of, respectively, the .MY and .COM.MY extensions.
- 5.3 The mere addition of the TLDs ".com" and ".my" to the Complainant's trade mark does not prevent a finding of confusing similarity.
- 5.3 The Respondent could not claim any legitimate rights over the mark PAYPAL. The term PAYPAL is neither generic nor a dictionary term or a common combination of two words. The Complainant has no relationship with the

Respondent and has never authorized the Respondent to use the Complainant's trade mark as a domain name. The Respondent has not commonly been known by the domain names and does not conduct any legitimate commercial or non-commercial business activity under the domain names.

- 5.4 There is no shred of evidence for actual or contemplated good faith use of the domain names by the Respondent.

B. Respondent

- 5.5 The Respondent has not submitted a valid Response under paragraph 6 of the Rules.

6. Discussions and Findings

Rule 17 of the MYDRP instructs the Panel to decide the proceeding based on the documents and evidence submitted by the Parties, the Policy and Rules as well as any other rules and principle of law which are applied in Malaysia.

Paragraph 5 of the MYDRP Policy provides that the Complainant must establish BOTH of the following elements in the Complaint:-

- (i) The Domain Name is identical or confusingly similar to a trade mark or service mark to which the Complainant has rights; and
- (ii) The Respondent has registered and/or used the Domain Name in bad faith

Identical or confusingly similar

The disputed domain names are identical with the Complainant's United States, Community Trade Mark and Malaysian registered trade mark for PAYPAL. The whole term 'PAYPAL' has been taken. The inclusion of the suffix .MY does nothing to detract the identicalness of the disputed domain names with the registered marks owned by the Complainant. As far as MYDRP as well as UDRP, it is well established that the mere inclusion of ccTLD is immaterial in determining whether the domain name is identical or confusingly similar to the Complainant's trade mark (*Volkswagen Group Singapore Pte Ltd v Webmotion Design*, Case No: rca/dndr/2003/01 (int)).

This is consistent with UDRP decisions whereby the mere addition of a non-significant element does not generally differentiate the domain name from the registered trade mark. "The incorporation of a trade mark in its entirety is sufficient to establish that a domain name is identical or confusingly similar to the Complainant's registered mark" (*Britannia*

Building Society v. Britannia Fraud Prevention, WIPO Case No. D2001-0505). The addition of the suffix .MY is just a geographical location or the country code of the domain name.

The fact that the Complainant has filed for the registration of the trade mark PAYPAL in Malaysia indicates that the Complainant has sufficiently proven his rights over the mark in Malaysia. In a domain case dispute, what is relevant is that the Complainant has a legitimate trade mark rights in the country where he is filing for the transfer of his domain name. It has to be noted that the first registration of the trade mark in Malaysia took place in 2005 with the priority date of 7 February 2003, whilst the disputed domain name <paypal.com.my> was registered on 11 August 2004. This means that the Complainant has secured rights over the trade mark PAYPAL in Malaysia before the Respondent registered the domain name in Malaysia.

Consequently, the Panel finds that the Complainant has shown that the disputed domain names are identical or confusingly similar to the trade marks in which the Complainant has rights.

Rights and Legitimate Interests

According to paragraph 7 of the Policy, the Respondent may prove his right and legitimate interest in the disputed domain names by substantiating evidence that:

- (i) Before the date of the Respondent being informed of the Complainant's dispute, the Respondent had used or made preparations to use the Domain Name or a name corresponding to the Domain Name in relation to a genuine offering of goods or services; or
- (ii) The Respondent is commonly known by the Domain Name even though he has yet to acquire any trade mark or service mark rights in the same name; or
- (iii) The Respondent is using the Domain Name for legitimate, non commercial and/or fair purposes and has no intention of using the same for profits or to deceive the public.

The Complainant contends that there is no way in which the Respondent could logically raise any of the three situations envisaged in paragraph 7 of the Policy. There is nothing to suggest that the Respondent is commonly known by the term PAYPAL. Nor has there been any evidence that the Respondent is licensed by the Complainant, as the rightful

owner of PAYPAL to use the trade mark for any commercial transaction. There is also nothing to suggest that the Respondent could possibly demonstrate its use or preparations to use either of the domain names in relation to a genuine offering of goods or services.

Absent of any justifiable reasons from the Respondent, there is no plausible reason which the Respondent could possibly claim that his usage of the domain names be anything other than trying to take advantage of the Complainant's goodwill and reputation.

Accordingly, the Panel finds that the Respondent has no rights or legitimate interests in respect of the disputed domain names.

Bad Faith.

Under the MYDRP Policy, a Complainant must prove both the element of identical or confusing similarity with registration or usage of such domain name in bad faith. Unlike UDRP, there is no need to prove both registration and usage of the domain name in bad faith. This is the distinguishing feature between MYDRP and UDRP and this has been indicated repeatedly in MYDRP decisions (*Hugo Boss AG v Eppies Internet*, Case No: rca/dndr/2004/02; *Google Inc v Digiattack*, Case No rca/dndr/2009/17).

Rule 6 of the MYDRP recognize the following registration as indicative of bad faith registration and/usage of the domain name in bad faith:

- i) For the purpose of sale, rent or transfer of the Domain Name for profit to the Complainant, its competitor or the owner of the trade mark or service mark; or
- ii) To prevent the owner of a trade mark or service mark from using the Domain Name which is identical with its trade mark or service mark; or
- iii) To disrupt the business of the Complainant; or
- iv) For the purposes of and with the intention to attract or divert, for commercial gain, Internet users to:
 - (a) the respondent's web site,
 - (b) or a web site of the Complainant's competitor;
 - (c) or any other web site and/ or online location,

by creating a possibility of confusion or deception that the web site and/or online location is operated or authorized by, or otherwise connected with the Complainant and/or its trade mark or service mark.

The Complainant contends that the Respondent registered both the disputed domain names with the intention of obtaining an unfair advantage of his goodwill and investments. This is supported from the fact that when the domain name was initially registered it was used to divert customers to the Respondent's own web site. Even though the Respondent eventually directs the domain name to the Complainant's own web site, it demonstrates that the Respondent registered the domain name with the intention of creating confusion or deception among the users of the Internet.

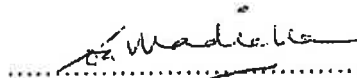
We are of the view that this is a straightforward case in which a domain name has been registered in bad faith. Although we do not have the privilege of hearing the Respondent's side of the story, we believe that there is no conceivable reason to dispute the assertions of the Complainant.

Accordingly, having regard to the circumstances of this particular case, the Panel finds that the Complainant has met its burden under paragraph 4(a)(iii) of the Policy.

7. Conclusion

In accordance with findings under paragraph 5 and 7 of the Policy and Rule 17 of the Rules, the Panel directs that the domain names <paypal.com.my> and <paypal.my> be transferred to the Complainant.

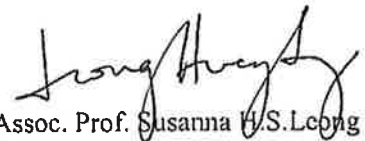
13th April 2011



Ia Madieha bt. Abdul Ghani Azmi
Presiding Panelist



Dr. Clive Trotman
Panelist



Assoc. Prof. Susanna H.S. Leong
Panelist